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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,446	01/28/2004	Douglas G. Vanderlaan	VTN5537DIV	3191

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PHILIP S. JOHNSON
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933-7003

EXAMINER

PENG, KUO LIANG

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 11/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/766,446

Applicant(s)

VANDERLAAN ET AL.

Examiner

Kuo-Liang Peng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/11/06 RCE.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21, 23 and 75-80 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21, 23 and 75-80 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 9/11/06.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 11, 2006 has been entered. Claims 1-2, 17 and 75-76 are amended. Claims 24-74 are deleted. Now, Claims 1-21, 23 and 75-80 are pending.

2. Claim objection(s) in the previous Office Action (Paper No. 031806) is/are removed.

3. Claim rejection(s) under 35 USC 112 in the previous Office Action (Paper No. 031806) is/are removed.

4. Claim rejection(s) under 35 USC 102 in paragraphs 9 and 10 of the previous Office Action (Paper No. 031806) is/are removed.

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5. The text of those sections of Title 35, U.S. code not included in this action can be found in prior Office Action(s).

Claim Objections

6. Claims 18-21 and 23 are objected to because of the following informalities:

In Claim 18 (line 1), should “further” be removed?

Appropriate correction is required.

Claim Rejections - 35 USC § 102

7. Claims 1-21, 23 and 75-80 are rejected under 35 U.S.C. 102(b) as being anticipated by Spinelli (US 5 314 960).

Spinelli discloses a method for preparing silicone hydrogel derived from monomers including the (meth)acryl-containing silicone monomer described in Figures 1A-1C, col. 7, lines 18-37. (col. 6, line 3 to col. 9, line 68 and Examples) Note that lowering the Young’s modulus and/or $\tan \delta$ **to the specific ranges set forth in the present invention** is an inherent outcome due to the incorporation of the instant (meth)acryl-containing silicone monomer because **Applicants’ specification admits** that when mPDMS is present in an amount between about 2 and 70wt% based on total weight of reactive monomer, depending on the other

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monomers present, this will generally reduce the modulus and $\tan \delta$ to the specific claimed ranges. (page 7, last paragraph to page 8, 1st paragraph). Furthermore, note that Spinelli's monomer described in col. 7, lines 13-38 is present in an amount falling within the aforementioned amount range of Applicants' mPDMS because Spinelli's macromonomer can be derived from a monomer mixture comprising the aforementioned Spinelli's monomer in an amount described in col. 7, lines 13-38 and the macromonomer can be in an amount as described in col. 9, lines 45-59. For Claims 9-11 and 76-78, Spinelli further teaches the use of a mixture of TRIS and other (meth)acryl-containing silicone monomers such as n-pentylhexamethyltrisiloxanylmethylmethacrylate, etc. (col. 17, lines 4-41)

For Applicants' argument (Remarks, page 8, last paragraph), arguing that Spinelli uses TRIS appears to be irrelevant because Spinelli does teach the use of a mono-alkyl terminated polydiorganosiloxane monomer as described in col. 7, lines 13-37 and Figures, which still read on that of Applicants'. The use of TRIS in Examples is merely a preferred embodiment.

8. Claims 1-21, 23 and 75-80 are rejected under 35 U.S.C. 102(a),(b) as being anticipated by Vanderlaan (EP 940 693).

Vanderlaan discloses a method for preparing silicone hydrogel derived from monomers including the (meth)acryl-containing silicone monomer of structures I, II and/or III ([0011], [0016]-[0017] and Examples) Note that lowering the Young's modulus and/or $\tan \delta$ **to the specific ranges set forth in the present invention** is an inherent outcome due to the incorporation of the instant (meth)acryl-containing silicone monomer because **Applicants' specification admits** that when mPDMS is present in an amount between about 2 and 70wt% based on total weight of reactive monomer, depending on the other monomers present, this will generally reduce the modulus and $\tan \delta$ to the specific claimed ranges. (page 7, last paragraph to page 8, 1st paragraph). Furthermore, note that the aforementioned Vanderlaan's silicone monomer is present in an amount falling within the aforementioned amount range of Applicants' mPDMS ([0029]-[0030] and Examples) For example, monomer T1 can be used in an amount of 35% as described in Table 3.

For Applicants' argument (Remarks, page 9, 3rd paragraph), Examiner is not able to find a basis that the present application claims priority as early as back to US Serial No. 09/532,943, which was filed March 2, 2000. Even if there were a support, Vanderlaan is still qualified as a 102(a) reference.

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9. The three references 09/652,817, 09/532,943 and 09/414,365 cited in the information disclosure statement filed on September 11, 2006 have been lined through because they are not U.S. patent documents. However, they have been fully considered.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair->

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direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp

November 10, 2006


Kuo-Liang Peng
Primary Examiner
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